

REMARKS

Claims 1-32 are pending in the application and are subject to restriction and/or election requirement. The claims have been restricted under 35 U.S.C. §§ 121 and 372 as follows:

- I. Claims 1-17, drawn to isolated nucleic acids encoding a fluorescent protein, vectors and host cells comprising said nucleic acids, methods of expressing said nucleic acids and their expression products.
- II. Claim 18, drawn to antibodies which specifically bind said expression products.
- III. Claim 19, drawn to transgenic organism comprising said nucleic acids.

In addition to inventions listed as Groups I-III above, the Examiner states each invention is additionally and independently directed to the following patentably distinct products of unrelated chemical structure and function:

- (a) SEQ ID NO:2 or DNA encoding it.
- (b) SEQ ID NO:4 or DNA encoding it.
- (c) SEQ ID NO:6 or DNA encoding it.
- (d) SEQ ID NO:8 or DNA encoding it.
- (e) SEQ ID NO:10 or DNA encoding it.
- (f) SEQ ID NO:12 or DNA encoding it.
- (g) SEQ ID NO:14 or DNA encoding it.
- (h) SEQ ID NO:16 or DNA encoding it.
- (i) SEQ ID NO:18 or DNA encoding it.
- (j) SEQ ID NO:20 or DNA encoding it.
- (k) SEQ ID NO:22 or DNA encoding it.
- (l) SEQ ID NO:24 or DNA encoding it.

Applicants provisionally elect Groups I and (a), with traverse. Applicants note that the claims identified in the restriction requirement are not the pending claims as

discussed on the telephone with the Examiner. The claims section shown herein properly recites the claims as filed upon entry into the national stage along with current amendments. In attempting to apply the above restriction requirement to the present claims, Applicants submit that claims readable on the elected invention include claims 1-8, 10, 12-15, 17, 19-21, 24-26, 28, 30-32 and 33.

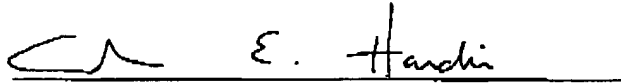
Regarding the restriction of Groups I and III, Applicants submit that identification of these groups as DNA and a transgenic organism alone fails to establish a lack of technical interrelationship or corresponding special technical features. The only acquired property (which is fluorescence) of a transgenic cell, or progeny thereof, as claimed arises due to introduction of the nucleic acid molecule encoding the fluorescent protein (Group I) inside the transgenic cells. Applicants amended the claims accordingly for clarity. Therefore, Applicants submit that the restriction between Groups I and III is improper and respectfully requests withdrawal thereof.

Applicants submit that SEQ IDs 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22 and 24 or DNA encoding them satisfy the requirement of having a technical interrelationship or corresponding special technical features as defined in PCT Rule 13.2. Further, this criterion shall be considered to be met when a single claim defines such alternatives if the alternatives are of a similar nature (not necessarily obvious variants) as in the present application. See, M.P.E.P. § 1850 I-III. In contrast to the Examiner's statement that Groups (a)-(I) represent products of unrelated structure and function, the identified SEQ IDs (except #2 and 14) represent fluorescent mutants of a non-fluorescent *Aequorea coerulescens* protein of SEQ ID 2, as clarified in the amended claims that recite substitutions of amino acid residues resulting in the fluorescent mutants of this parent protein and substitutions increasing fluorescence yield and folding. Therefore, Applicants submit the restriction requirement between Groups (a)-(I) is improper and respectfully requests withdrawal thereof.

PATENT
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Having addressed all issues set out in the office action, Applicants respectfully request further prosecution of the pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "C. E. Hardie", is written over a horizontal line.

Chance E. Hardie
Registration No. 55,247
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants